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12 Claimants CYLINK, CARO-KANN CORPORATION
AND THE BOARD OF TRUSTEES OF THE
13 LELAND STANFORD JUNIOR UNIVERSITY

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

16 ROGER SCHLAFLY,

17 Plaintiff,

18 v.

19 PUBLIC KEY PARTNERS AND RSA DATA
20 SECURITY, INC.,

21 Defendants,

22
23 RSA DATA SECURITY, INC.,

24 Plaintiff,

25 v.

26 CYLINK CORPORATION and CARO-KANN
27 CORPORATION, et al.

28 Defendants.

No. C-94-20512 SW

~~OBJECTIONS OF STANFORD~~
UNIVERSITY, CYLINK AND CARO-
KANN TO THE PROPOSED JURY
INSTRUCTIONS ON CLAIM
CONSTRUCTION OF RSA DATA
SECURITY, INC.

Date: October 1, 1996

Time: 10:00 a.m.

Judge: Hon. Spencer Williams

No. ~~C-96-20094 SW~~

1 Pursuant to this Court's Order, defendants and counter-
 2 claimants, Cylink Corporation, Caro-Kann Corporation and The Board
 3 of Trustees of the Leland Stanford Junior University, hereby file
 4 the following objections to the Proposed Jury Instructions of RSA
 5 Data Security, Inc., in connection with the hearing on claim
 6 construction scheduled for October 1, 1996:¹

7 1. Hellman-Merkle proposed Instruction Nos. 1.00, 1.11,
 8 1.21, 1.31, 1.41, 1.51, 2.2, 2.11, 2.12, 3.2, 3.21, 3.22, 3.23,
 9 4.20, 4.21, 4.22, 4.23, 4.24, 5.10, 5.11, 5.12, 5.13, 5.14 and
 10 all other instructions incorporating such instructions by
 11 reference are objectionable because they incorrectly refer to
 12 the method claims of the Hellman-Merkle patent as "step for"
 13 claims subject to 35 U.S.C. § 112, ¶ 6. As shown in the
 14 Markman Hearing Brief of Stanford University, Cylink and Caro-
 15 Kann, the reference claims are method claims not subject to 35
 16 U.S.C. § 112, ¶ 6.

17 2. Hellman-Merkle proposed Instruction Nos. 1.00, 2.10,
 18 2.2, 3.10, 3.2, 4.20, 5.10 and 6.0 and all other instructions
 19 incorporating such instructions by reference are objectionable
 20 because they inappropriately narrow the definition of the
 21 accused products to only certain of RSA Data Security, Inc.'s
 22 products. Such a narrow limitation is inappropriate at this
 23 time as explained fully in the accompanying memorandum
 24 regarding jury instructions.

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27 ¹ The accompanying Memorandum of Stanford University, Cylink,
 28 and Caro-Kann Regarding the Parties' Proposed Jury Instructions sets
 forth the legal and factual bases for these objections in detail.

1 3. Hellman-Merkle proposed Instruction Nos. 1.00, 1.11,
2 2.2, 2.11, 3.2, 3.21, 4.20, 4.21, 5.10, 5.11, 6.0, 6.21 are
3 objectionable as incorrectly confusing the elements of the
4 patent disclosure that are incorporated if 35 U.S.C. § 112, ¶ 6
5 applies to the claims. RSA Data Security requests the jury to
6 compare both "structures and acts" in the disclosure with the
7 accused products, which is inappropriate under 35 U.S.C. § 112,
8 ¶ 6 (stating "structure, material, or acts") and the case law
9 interpreting that provision as explained more fully in the
10 accompanying Memorandum Regarding Jury Instructions.

11 4. Hellman-Merkle proposed Instruction Nos. 1.00, 2.2,
12 3.2, 4.20, 5.10 and 6.0 and all other instructions
13 incorporating such instructions by reference are objectionable
14 for improperly requiring that the infringing products follow
15 the method acts in the sequential order in which the acts are
16 recited in the claim rather than the operative order, if any,
17 required by the meaning of the language of the claims as
18 explained more fully in the accompanying Memorandum Regarding
19 Jury Instructions.

20 5. Hellman-Merkle proposed Instruction Nos. 1.00, 1.11,
21 1.21, 1.31, 1.41, 1.51, 2.2, 2.11, 2.12, 3.2, 3.21, 3.22, 3.23,
22 4.20, 4.21, 4.22, 4.23, 4.24, 5.10, 5.11, 5.12, 5.13, 5.14,
23 6.10, 6.20, 6.21, 6.22, 6.30 and 6.40 and all other
24 instructions incorporating such instructions by reference are
25 objectionable for improperly characterizing, paraphrasing or
26 referencing the parts of the disclosure of the Hellman-Merkle
27 patent specification alleged to correspond to the "means" or
28

1 "step" elements of the asserted claims as explained more fully
2 in the accompanying Memorandum Regarding Jury Instructions

3 6. Hellman-Merkle proposed Instruction Nos. 1.41 and
4 6.20 and all other instructions incorporating such instructions
5 by reference are objectionable as improper attempts to rewrite
6 the claim language of the Hellman-Merkle patent claims as
7 explained more fully in the accompanying Memorandum Regarding
8 Jury Instructions.

9 7. Hellman-Merkle proposed Instruction Nos. 2.0 and 3.23
10 and all other instructions incorporating such instructions by
11 reference are objectionable as containing argument unrelated to
12 the issues of claim construction as explained more fully in the
13 accompanying Memorandum Regarding Jury Instructions

14 8. Hellman-Merkle proposed Instruction Nos. 1.12, 1.22,
15 1.32, 1.33, 1.34, 1.42, 1.43, 1.44, 1.52, 2.0, 2.12, 3.22,
16 3.30, 4.3, 5.20, 5.30, 6.12, 6.24, 6.25, 6.26, 6.27, 6.31 and
17 6.41 and all other instructions incorporating such instructions
18 by reference are objectionable as containing definitions of
19 claim terms that contradict the patent claim language itself,
20 the patent specification, the prosecution history, the commonly
21 understood definitions of those of ordinary skill in the art,
22 and the expert testimony of RSADSI's own experts and
23 Mr. Schlafly as explained more fully in the accompanying
24 Memorandum Regarding Jury Instructions

25 9. Diffie-Hellman proposed instruction No. 1.00 is
26 objectionable as exceeding the scope of an instruction on claim
27 construction and improperly recounting the evidence and
28 reasoning used by the Court in arriving at that construction as

1 explained more fully in the accompanying Memorandum Regarding
2 Jury Instructions.

3 10. Diffie-Hellman proposed Instruction Nos. 1.00 and
4 2.00 are objectionable insofar as both are based on improper
5 and incorrect legal arguments as explained more fully in the
6 accompanying Memorandum Regarding Jury Instructions.

7 11. Diffie-Hellman proposed Instruction Nos. 1.00, 2.00,
8 3.00, 3.01, 3.20. and 3.30 are objectionable insofar as each
9 seeks improperly to limit the plain language of the claims, as
10 explained more fully in the accompanying Memorandum Regarding
11 Jury Instructions.

12 12. Diffie-Hellman proposed Instruction No. 3.01 is
13 objectionable as instructing the jury to read the functions
14 disclosed in the specification into the claims, as explained
15 more fully in the accompanying Memorandum Regarding Jury
16 Instructions.

17 13. All of the instructions of RSA Data Security, Inc.
18 are objectionable to the extent that each contains the defects
19 noted above and/or is contrary to the law of the facts of the
20 case.

21 Dated: September 24, 1996

22 MORRISON & FOERSTER LLP
23 ALSTON & BIRD

24 By: 

Karl J. Kramer

25 Attorneys for Defendants and
26 Counter-Claimants CYLINK
27 CORPORATION, CARO-KANN
28 CORPORATION AND THE BOARD OF
TRUSTEES OF THE LELAND STANFORD
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